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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,702	09/07/2004	Michael J Breslin	21047YP	3343
210 7590 04/14/2009 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER HAYLIN, ROBERT H				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
04/14/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/506,702

Applicant(s)

BRESLIN ET AL.

Examiner

ROBERT HAVLIN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 10 is/are rejected.
- 7) ☒ Claim(s) 6 and 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the claims: Claims 6 and 8-10 are currently pending.

Restriction/Election: Applicant previously elected group I and the following species:

5-(2-amino-3-phenylpropyl)-2-(2,5-difluorophenyl)-N,N-dimethyl-5-phenyl-4,5-dihydro-1H-pyrazole-1-carboxamide



for examination. The scope of examination was expanded beyond the elected species within the scope of claim 6 and art was found rendering the claim obvious. Because the generic claim encompassing the elected species was found unpatentable (as detailed in the new rejection below), the scope of the claims examined remains restricted to the elected species only.

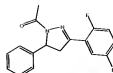
RESPONSE TO APPLICANT REMARKS

Claim Objections

1. Claims 8, and 10 were objected to as being dependent on a rejected base claim. Claims 6, 8-10 were objected to for reading on non-elected subject matter in view of the restriction to the scope of the elected species. **These objections are maintained** because of the following new rejections.

Claim Rejections - 35 USC § 103

2. Claims 6 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi et al. (CAPLUS Abstract of Joshi et al., Journal of the Indian Chemical Society (1984), 61(11-12), 1014-15. Accession # 1986:34035.) in view of Silverman, R. B. (The Org. Chem. of Drug Design and Drug Action, Academic Press, Inc.: San Diego, 1992, pp. 4-51).



The claims include the compound (listed in claim 6): 1-Acetyl-3-(2,5-dichlorophenyl)-5-phenyl-4,5-dihydro-1H-pyrrole

Applicant argues that the 2,5-substitution of the phenyl above produced and unexpected result as taught by the Cox et al. reference cited. However, the alleged unexpected result is that over the *monohalogenated* analog and not the dihalogenated which is the relevant comparison. In addition, the data provided does not compare the prior art 3,4-disubstituted analog. Furthermore, claim 6 is for compounds including 2-Cl, 3-Cl, which equally apply to the SAR methodology taught by Silverman.

Therefore, applicant has not met their burden in demonstrating how the unexpected result would be applicable to the entire claim scope. See MPEP 716.02(b).

This rejection is **maintained**.

Conclusion

The claims are in not condition for allowance. **THIS ACTION IS MADE FINAL.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

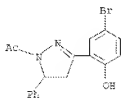
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The examiner would also like to make the following art of record:

CAPLUS Abstract of Sangwan et al., *Chimica Acta Turcica* (1983), 11(1), 65-72, which teaches pharmacological activity of compounds including the following 2,5-



substituted species:

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/
Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626